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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|-----------------|-------------|----------------------|---------------------|------------------|
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10/578,704

04/27/2007

Shoji Osaka

60233-030

3702

27305

7590

04/08/2011

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EXAMINER

SMITH, PHILIP ROBERT

ART UNIT

PAPER NUMBER

3779

MAIL DATE

DELIVERY MODE

04/08/2011

PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

|                              |                        |                     |  |
|------------------------------|------------------------|---------------------|--|
| <b>Office Action Summary</b> | <b>Application No.</b> | <b>Applicant(s)</b> |  |
|                              | 10/578,704             | OSAKA, SHOJI        |  |
|                              | <b>Examiner</b>        | <b>Art Unit</b>     |  |
|                              | PHILIP R. SMITH        | 3779                |  |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☒ Responsive to communication(s) filed on 10 May 2006.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 1-12 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☐ Claim(s) \_\_\_\_\_ is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☒ Claim(s) 1-12 are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                     | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____                                      |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)          | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____  | 6) <input type="checkbox"/> Other: _____                          |

## **DETAILED ACTION**

### **Summary**

- [01] The application contains 12 claims, some directed to devices, and some directed to methods. The devices and methods are patentably distinct as set forth beginning at paragraph [03]. In addition, a specific embodiment of imaging arrangement must be elected, and a specific embodiment of illumination arrangement must be elected.
- [02] A complete response to the restriction requirement contains the following:
- [02a] An election of either the methods (10-12) or the devices (1-9).
  - [02b] An election of a single imaging arrangement to be examined, and an identification of the claims that comport with the elected imaging arrangement.
  - [02c] An election of a single illumination arrangement to be examined, and an identification of the claims that comport with the elected illumination arrangement.

### **Restriction**

- [03] Restriction to one of the following inventions is required under 35 U.S.C. 121:
- [03a] Claim(s) 1-9, drawn to various devices.
  - [03b] Claim(s) 10-12, drawn to various methods.
- [04] The inventions are distinct because of the following reason:
- [04a] The inventions are related as processes and apparatus for the practice of those processes. The inventions are distinct if it can be shown that either: (1) the process as claimed can be practiced by another materially different apparatus or by hand, or (2) the apparatus as claimed can be used to practice another and materially different process.

(MPEP § 806.05(e)). In this case, the devices may be used without the steps of capturing testing large parts.

[05] Restriction for examination purposes as indicated is proper because all these inventions listed in this action are independent or distinct for the reasons given above and there would be a serious search and/or examination burden if restriction were not required because at least the following reason(s) apply:

[05a] the inventions have acquired a separate status in the art in view of their different classification.

[05b] the inventions have acquired a separate status in the art due to their recognized divergent subject matter.

[05c] the inventions require a different field of search (e.g., searching different classes /subclasses or electronic resources, or employing different search strategies or search queries).

[06] Applicant is advised that the reply to this requirement to be complete must include (i) an election of a invention to be examined even though the requirement may be traversed (37 CFR 1.143) and (ii) identification of the claims encompassing the elected invention.

[07] The election of an invention may be made with or without traverse. To reserve a right to petition, the election must be made with traverse. If the reply does not distinctly and specifically point out supposed errors in the restriction requirement, the election shall be treated as an election without traverse. Traversal must be presented at the time of election in order to be considered timely. Failure to timely traverse the requirement will result in the loss of right to petition under 37 CFR

1.144. If claims are added after the election, applicant must indicate which of these claims are readable upon the elected invention.

- [08] Should applicant traverse on the ground that the inventions are not patentably distinct, applicant should submit evidence or identify such evidence now of record showing the inventions to be obvious variants or clearly admit on the record that this is the case. In either instance, if the examiner finds one of the inventions unpatentable over the prior art, the evidence or admission may be used in a rejection under 35 U.S.C. 103(a) of the other invention.

#### **Election of Species According to the Figures**

- [09] This application is directed to the following patentably distinct species of imaging arrangement:
- [09a] the arrangement of Figure(s) 4, wherein there is a single imaging element;
  - [09b] the arrangement of Figure(s) 6, wherein there are distinct imaging elements for each field of view;
  - [09c] the arrangement described on page 12 of the specification, wherein the imaging element 15 is disposed in the operation unit 2.
- [10] This application is directed to the following patentably distinct species of illuminating arrangement:
- [10a] the arrangement having an illuminating probe;
  - [10b] the arrangement described on page 13 of the specification, wherein a plurality of illumination lenses may be disposed correspondingly to the objective lenses 11.
- [11] The species are independent or distinct because they
- [11a] do not overlap in scope. See MPEP §806.04(b).
  - [11b] are mutually exclusive. See MPEP §806.04(f).

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- [11c] In addition, these species are not obvious variants of each other based on the current record.
- [12] Applicant is required under 35 U.S.C. 121 to elect a single disclosed species, or a single grouping of patentably indistinct species, for prosecution on the merits to which the claims shall be restricted if no generic claim is finally held to be allowable.
- [13] There is a search and/or examination burden for the patentably distinct species as set forth above because at least the following reason(s) apply:
- [13a] the species or groupings of patentably indistinct species have acquired a separate status in the art in view of their different classification.
- [13b] the species or groupings of patentably indistinct species have acquired a separate status in the art due to their recognized divergent subject matter.
- [13c] the species or groupings of patentably indistinct species require a different field of search (e.g., searching different classes /subclasses or electronic resources, or employing different search strategies or search queries).
- [14] Applicant is advised that the reply to this requirement to be complete must include (i) an election of a species or a grouping of patentably indistinct species to be examined even though the requirement may be traversed (37 CFR 1.143) and (ii) **identification of the claims encompassing the elected species or grouping of patentably indistinct species**, including any claims subsequently added. An argument that a claim is allowable or that all claims are generic is considered nonresponsive unless accompanied by an election.
- [15] The election may be made with or without traverse. To preserve a right to petition, the election must be made with traverse. If the reply does not distinctly and specifically point out supposed errors in

the election of species requirement, the election shall be treated as an election without traverse.

Traversal must be presented at the time of election in order to be considered timely. Failure to timely traverse the requirement will result in the loss of right to petition under 37 CFR 1.144. If claims are added after the election, applicant must indicate which of these claims are readable on the elected species or grouping of patentably indistinct species.

- [16] Should applicant traverse on the ground that the species, or groupings of patentably indistinct species from which election is required, are not patentably distinct, applicant should submit evidence or identify such evidence now of record showing them to be obvious variants or clearly admit on the record that this is the case. In either instance, if the examiner finds one of the species unpatentable over the prior art, the evidence or admission may be used in a rejection under 35 U.S.C. 103(a) of the other species.
- [17] Upon the allowance of a generic claim, applicant will be entitled to consideration of claims to additional species which depend from or otherwise require all the limitations of an allowable generic claim as provided by 37 CFR 1.141.

### **Conclusion**

- [18] Any inquiry concerning this communication or earlier communications from the examiner should be directed to Philip R Smith whose telephone number is (571) 272 6087 and whose email address is philip.smith@uspto.gov. The examiner can normally be reached between 9:00am and 5:00pm. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Tom Sweet, can be reached on (571) 272 4761. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information

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for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

/Philip R Smith/  
Primary Examiner, Art Unit 3779